Paper No. 11
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB OCT. 22,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prestige Medical Corporation

Serial No. 75/267,267

Lori N. Boatright, Thomas M. Coester and Eric S. Hyman of Blakely, Sokoloff, Taylor & Zafman for applicant.

Steven R. Fine, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Quinn, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Prestige Medical Corporation to register the mark PRESTIGE GIFTS for "novelties in the nature of pens, pre-imprinted with professional occupational slogans."[1]

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the

ground that applicant's mark, if applied to applicant's goods, would so resemble the previously registered mark PRESTIGE shown below

for "lead pencils, crayons, pencil leads, lumber leads, pencil point protectors, pencil holders, pencil lengtheners, pencil cases, lead boxes, mechanical pencils, penholders, metallic pens, stylographic pens, fountain pens, rubber erasers, and desk sets"[2] as to be likely to cause confusion.

When the refusal was made final, applicant appealed.[3] Applicant and the Examining Attorney filed briefs.

The essence of applicant's argument of no likelihood of confusion between its mark and registrant's cited mark is that the cited mark is entitled to only a narrow scope of protection. In this connection, applicant introduced twenty third-party registrations for marks comprising PRESTIGE (or PRESTIGIOUS), in whole or in part, which have issued in International Class 16. Applicant also argues

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[1] Application Serial No. 75/267,267, filed April 1, 1997, alleging a bona fide intention to use the mark in commerce.
[2] Registration No. 290,856, issued January 19, 1932; thrice renewed.
[3] As pointed out by applicant, and confirmed by the Examining Attorney in his brief, the reference to Registration No. 143,598 in the final refusal was incorrect.

that the addition of the word “GIFTS” distinguishes the marks. More specifically, applicant contends that PRESTIGE, as used by registrant, is likely to connote a certain air of quality or cache associated with the goods, as compared to the presence of PRESTIGE in applicant’s mark which, according to applicant, creates an incongruity in the sense that “prestige” is the antithesis of novelties. Thus, applicant concludes, the marks convey “wholly different commercial impresssion[s].” As to the goods, applicant asserts that its primary business is supplying health care providers with medical devices, and that its pens are novelty items which are pre-imprinted with occupational slogans primarily for promotional purposes. According to applicant, these pens will be sold through applicant’s catalogs and its own stores.

The Examining Attorney contends that the marks and goods are substantially similar. The Examining Attorney also points out that applicant’s identification of goods does not include any restrictions as to trade channels.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of

confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Food, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Insofar as the goods are concerned, we find registrant's pens and applicant's novelty pens to be substantially similar. Registrant's identification of goods is not restricted and we must assume, therefore, that registrant's "metallic pens" and "fountain pens" could encompass the type of pens sold by applicant, that is, pens sold with pre-imprinted slogans on them. Also, inasmuch as registrant's and applicant's identifications of goods do not include any restrictions as to trade channels, we must assume that the pens would travel in similar, if not the same, trade channels to the same classes of purchasers.

With respect to the marks, registrant's PRESTIGE mark and applicant's PRESTIGE GIFTS mark are substantially similar in sound, appearance and meaning. Applicant has appropriated the entirety of registrant's mark and merely added the subordinate, descriptive word "GIFTS" to it. These similarities clearly outweigh any incongruity in commercial impression as argued by applicant.[4]

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[4] We take judicial notice that the term "prestige" is defined as "a high reputation or influence arising from success,

In finding that there is a likelihood of confusion here, we acknowledge that the term “prestige” is a laudatorily suggestive term, and that arguably registrant’s mark is entitled to what applicant characterizes as a “narrow scope of protection.” Nonetheless, laudatorily suggestive marks, such as registrant’s, are protectable, and especially in a case where, as here, substantially similar goods are involved.

The third-party registrations submitted by applicant do not compel a different result in this case. The registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and the existence on the register of confusingly similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); and Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967). Further, none of the registered marks covers the specific type of product involved here, namely pens.

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achievement, rank, or the like.” *The Random House College Dictionary* (1980)

To the extent that any of the points raised by applicant may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.

T. J. Quinn

C. E. Walters

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial
and Appeal Board